



INNOVATION AND INTELLECTUAL PROPERTY

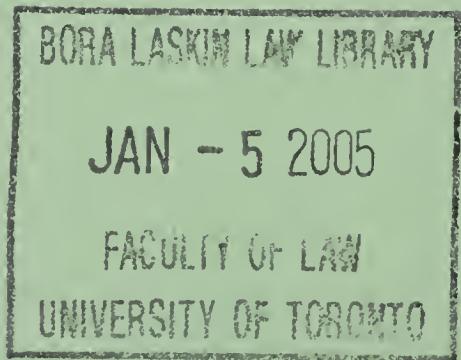
INTENSIVE COURSE

Distinguished Visiting Professor Joseph Straus

Faculty of Law

University of Toronto

2005



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INNOVATION AND INTELLECTUAL PROPERTY (LAW 478 H1S)

Distinguished Visiting Professor Joseph Straus

Weeks of January 31 and February 7, 2005

A. Legal Instruments of Intellectual Property Protection

I. Different Protection Systems for Intellectual Property Rights – common characteristics and differences

1. Goldstein, The Nature and Function of Intellectual Property Law, in: Goldstein, Copyright, Patent, Trademark and related State doctrines, 5th Edition, 2003

II. Fundamentals of Patent Law

- 1. Schechter/Thomas, Principles of Patent law, Chapter 1, pp.1-22*
- 2. Beier, F.K., The significance of the Patent System for Technical, Economic and Social Progress, 11 IIC 563-584 (1980)*

III. International Treaties and Agreements and their implications in the field of patent law

1. International Treaties:

- Paris Convention 1883, latest revision 1967 (Stockholm) (MIPLC-Reader, No. 120)
- Patent Cooperation Treaty (PCT) 1970, modified in 1984 (MIPLC-Reader, No. 410)
- European Patent Convention (EPC) 1973, latest Revision Nov. 2000 (not yet adopted) (MIPLC-Reader, No. 430)
- The Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS) 1995 (MIPLC-Reader, No. 250)
- Patent Law Treaty (PLT) 2000 (MIPLC-Reader, No. 420)
- Community Patent Convention (CPC) (latest draft 2003, not yet adopted)
<http://clea.wipo.int/PDFFILES/English/EU/EU007EN.PDF>
- Substantive Patent Law Treaty (SPLT) (latest draft 2003, not yet adopted)
http://www.wipo.int/scp/en/documents/session_10/pdf/scp10_2.pdf

2. Canada – Patent Protection of Pharmaceutical Products, WTO, Dispute Settlement 114, WT/DS114/13

3. Straus, Implications of the TRIPS Agreement in the Field of Patent Law, in: Beier/Schricker, From GATT to TRIPS, IIC –Studies Volume 18, p. 160 - 215

4. Geneva Declaration on the future of the World Intellectual Property Organisation

5. Stiglitz, How to fix the IP imbalance, Interview given to Sam Mamudi, Managing Intellectual Property, October 2004, p. 28-31.

B. Patent eligibility – different approaches

1. Ex parte Schreier - Rote Taube - Red Dove, German Federal Supreme Court, 1969, 1 IIC 136-142 (1970).

2. *Diamond v. Chakrabarty*, 447 U.S. 303 (1980).
3. *Harvard College v. Canada (Commissioner of Patents)*, Canadian Supreme Court, December 5, 2002, IIC 2003, 656
4. Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (Biotechnology-Directive), Art. 5 (2), Recitals 20, 21, 23 (MIPLC-Reader, No. 470)

C. Exceptions to Patent Eligibility under the European Statutory approach

I. Inventions the publication or exploitation of which would be contrary to "ordre public" or "morality" (Art. 53a)

EU Dir. Art., 6; Recitals 36, 37, 39, 40, 41, 42, 45; EPC Rules 23d, 23e (1)

II. Plant or animal varieties and essentially biological processes for the production of plants or animals (Art. 53b)

EU Dir. Art. 4 (1), Recital 29, 32

1. T 19/90 - *Onco-mouse/Harvard II*, IIC 1991, 74-84; OJ EPO 1990, 476.
2. Decision of the Opposition Division of November 7, 2001 – *Onco-mouse/HARVARD*, OJ EPO 2003, 473.
3. G 1/98 – *Transgenic Plant/Novartis II*, IIC 2000, 430-441; OJ EPO 2000, 111-141
4. *Straus*, Biotechnology and Patents, Chimia 54 (2000), 293-298.

D. Patentability Requirements

I. Enabling disclosure/written specification (EPC Art. 83; Rule 28; EU Biotech Dir. Art. 13; 35 U.S.C. § 112; Budapest Treaty¹)

1. T 292/85 – *Polypeptide Expression/GENENTECH*, OJ EPO 1989, 275, No. 3
2. T 412/93 – *Erythropoietin/AMGEN*, Nos. VI (2), 15-29, 74-97, 112, 113-114
3. *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988)
4. *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916 (Fed. Cir. 2004)
5. *In re Wallach*, 378 F.3d 1330 (Fed. Cir. 2004)

II. Novelty/ Anticipation (EPC Art. 54, 55; 35 U.S.C. § 102)

1. *Rogge*, The concept of Novelty and European Patent Law, 28 IIC 443 (1997)
2. EBA G 1/92 – *Availability to the public*, OJ EPO 1993, 277-280
3. TBA T 207/94 – *Human beta-Interferon/BIOGEN*, OJ EPO 199, 273
4. EBA G 0005/83 – *Second Medical Indication/EISAI*, OJ EPO 1985, 64.

¹ Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure

III. Inventive step/ Non-obviousness (EPC Art. 56; 35 U.S.C. § 103)

1. TBA T 292/85 – *Polypeptide Expression/GENENTECH*, OJ EPO 1989, 275 (See above)
2. TBA T 207/94 – *Human beta-Interferon/BIOGEN*, (Nos. 22-44), OJ EPO 199, 273 (see above)
3. *In re Dillon*, 919 F. 2d 688 (Fed. Cir. 1990)
4. *In re Deuel*, 51 F. 3d 1552 (Fed. Cir. 1995)

IV. Industrial Applicability/ Utility (EPC Art. 57; 35 U.S.C. § 101)

1. Biotechnology Directive Art. 5 (3) Recital 22, 23, 24
2. Decision of the Opposition Division of June 21, 2001 – *Novel V28 seven transmembrane receptor/ICOS*, OJ EPO 2002, 293
3. *In re Brana*, 51 F. 3d 1560 (Fed. Cir. 1995)
4. *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77 (S.Ct. Canada 2002) (sound prediction doctrine)

E. Scope of Protection

1. *Kirin Amgen v Hoechst Marion Roussel*, House of Lords, [2004] UKHL 46.
2. *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916 (Fed. Cir. 2004) (see above)
3. *Genzyme Corp. v. Transkaryotic Therapies, Inc.*, 346 F.3d 1094 (Fed.Cir. 2003)
4. *Astrazeneca AB v. Mutual Pharmaceutical*, 384 F.3d 1333 (Fed. Cir 2004).
5. *Schmeiser v. Monsanto Canada Inc.*, Canadian Supreme Court, Decision of 21.5.2004, [2004] SCC 34
6. *Clinical Tests*, Federal Supreme Court of Germany, Decision of 11.07.1995, 28 IIC 103 (1997)
7. *Integra v. Merck*, 331 F.3d 860 (Fed. Cir. 2003)
8. *Straus*, An updating concerning the protection of biotechnological inventions, including the scope of patents for genes – An academic point of view, OJ EPO 2003, 166-188.

F. Patents for Computer-Implemented Inventions

1. *State Street Bank & Trust Co. v. Signature Financial Group Inc*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed.Cir.1998).
2. T 931/95 – *Pension Benefits System/ PBS Partnership*, OJ EPO 2001, 441
3. T 641/00 – *Two Identities/COMVIK*, OJ EPO 2003, 352
4. Proposal for a Directive of the European Parliament and of the Council on the patentability of computer-implemented inventions

Plant Variety Protection

1. International Convention on the Protection of New Varieties of Plants (UPOV) 1961, revised in 1978 and 1991 (MIPLC Reader No. 510)
2. Council Regulation (EC) No. 2100/94 of 27 July 1994 on Community plant variety rights, *Official journal NO. L 227, 01/09/1994*
2. ECJ, C-305/00 - *Schulin*
3. U.S. Supreme Court: *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc.*
4. *Straus*, Measures Necessary for the Balanced Co-Existence of Patents and Plant Breeders' Rights - A Predominantly European View, WIPO-UPOV/SYM/02/
5. *Moufang*, The Interface Between Patents and Plant Variety Rights in Europe, WIPO-UPOV/SYM/03/6